

### **REMARKS**

Applicants respectfully request reconsideration. Claims 1-2, 4-11, 13, 15, 17-19, 22, 28, 30-31, 34-37, 81-82, and 93-98 were pending in the application. Claims 1, 81 and 98 have been amended. Claims 99-121 have been added. Claims 1, 2, 4-11, 13, 15, 17-19, 22, 28, 30-31, 34-37, 81-82, and 93-121 are now pending in this application with claims 1, 81 and 98 being independent claims. No new matter has been added.

#### **Summary of Interview with Examiner**

Representatives Jessamine N. Lee, Registration No. 61,674, and Timothy J. Oyer, Registration No. 36,628, and (hereinafter, “the representatives”), thank Patent Examiner Nelson Yang for a telephone interview conducted on May 12, 2011 (hereinafter, “the interview”).

On May 9, 2011, the representatives sent a facsimile of proposed claim amendments for discussion purposes only to Examiner Yang. A copy of the proposed claim amendments is included with this response as Appendix A. It is noted that the actual claim amendments made herein differ from the proposed claim amendments of Appendix A.

During the interview, the prior art cited in the Office Action mailed February 8, 2011, U.S. Patent No. 6,488,894 (hereinafter, “Miethe”); U.S. Patent No. 5,268,147 (hereinafter, “Zabetakis”); and U.S. Patent Publication No. 2002/0092767 (hereinafter, “Bjornson”), were discussed. The representatives noted aspects of the “transferring” recitation of independent claim 1 and that Miethe *teaches away* from the recited arrangement. The representatives and Examiner Yang also discussed the disclosure of Zabetakis. The representative believe that Examiner Yang is inclined to allow independent claim 1 as amended, to specify that the third fluid is adjacent to and substantially immiscible with the first and second fluids, and that this would overcome the rejection of these claims over Miethe in view of Zabetakis. The representatives had noted that Zabetakis does not cure the deficiencies of Miethe with respect to the claim as amended in this manner. Examiner Yang also noted that amending independent claims 81 and 98 to specify a step of applying the first, third and second fluids to the reaction site would overcome the rejection of these claims over Bjornson in view of Miethe. The amendments and remarks filed herewith are essentially a complete record of the substance of the discussion during the interview.

Rejections Under 35 U.S.C. §103

Claims 1, 2, 6-11, 15, 17, 18, 19, 28, 94 and 96 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Miethe in view of Zabetakis.

Without conceding to the correctness of the rejection, independent claim 1 has been amended to recite that the third fluid is adjacent to and substantially immiscible with the first and second fluids. As noted above, the Examiner indicated in the interview that such an amendment to independent claim 1 would overcome the asserted combination of Miethe in view of Zabetakis.

Accordingly, independent claim 1 is believed to be patentable over the asserted combination of Miethe in view of Zabetakis. The remaining claims that stand rejected on this ground each depend, directly or indirectly, from independent claim 1, and are believed to be patentable over the asserted combination of Miethe in view of Zabetakis for at least the same reasons as for independent claim 1.

Claims 30-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miethe in view of Zabetakis as applied to claim 1 above, and further in view of U.S. Patent Publication No. 2002/0199094 to Strand et al. (hereinafter, "Strand").

As described above, independent claim 1 is believed to be patentable over Miethe in view of Zabetakis. Furthermore, Strand does not remedy the deficiencies of the combination of Miethe in view of Zabetakis for independent claim 1 prior to its amendment herein. For at least these reasons, independent claim 1 is believed to be patentable over Miethe in view of Zabetakis and further in view of Strand. Therefore, claims 30-31 which depend from independent claim 1, are patentable over the asserted combination of Miethe in view of Zabetakis and further in view of Strand.

Claims 4-5, 13, 93, and 97 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miethe in view of Zabetakis as applied to claim 1 above, and further in view of Bjornson.

As described above, independent claim 1 is believed to be patentable over Miethe in view of Zabetakis. Furthermore, Bjornson does not remedy the deficiencies of the combination of Miethe in view of Zabetakis with respect to independent claim 1 prior to its amendment herein. For at least

these reasons, independent claim 1 is believed to be patentable over Miethe in view of Zabetakis and further in view of Bjornson. Therefore, claims 4-5, 13, 93, and 97, which depend directly or indirectly from independent claim 1, are patentable over the asserted combination of Miethe in view of Zabetakis and further in view of Bjornson.

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Miethe in view of Zabetakis, as applied to claim 1 above, and further in view of U.S. Patent Publication No. 2002/0001818 to Brock (hereinafter, "Brock").

As described above, independent claim 1 is believed to be patentable over Miethe in view of Zabetakis. Furthermore, Brock does not remedy the deficiencies of the combination of Miethe in view of Zabetakis for independent claim 1 prior to its amendment herein. For at least these reasons, independent claim 1 is believed to be patentable over Miethe in view of Zabetakis and further in view of Brock. Therefore, claim 34, which depends from independent claim 1, is patentable over the asserted combination of Miethe in view of Zabetakis and further in view of Brock.

Claims 81, 82, and 98 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bjornson in view of Miethe.

Without conceding to the correctness of the rejection, each of independent claims 81 and 98 have been amended to recite the step of applying in series the first, third and second fluids to the reaction site, where the third fluid is adjacent to and substantially immiscible with the first and second fluids. As noted above, the Examiner indicated in the interview that such an amendment to independent claims 81 and 98 would overcome the asserted combination of Bjornson in view of Miethe.

Therefore, independent claims 81 and 98 are believed to be patentable over the asserted combination of Bjornson in view of Miethe. Claim 82 depends from independent claim 81 and is believed to be patentable over the asserted combination of Bjornson in view of Miethe for at least these same reasons.

Accordingly, Applicants respectfully request withdrawal of the claim rejection on these grounds.

#### New Claims

New claims 99-121 have been added and are supported in the specification as filed. The subject matter in each of new claims 99-121 was present in a claim that was pending in this application prior to this amendment. No new matter has been added. Furthermore, each of new claims 99-121 depends, directly or indirectly, from either independent claim 81 or 98, which are believed to be patentable for at least the reasons described above. Accordingly, new claims 99-121 are also believed to be patentable.

#### CONCLUSION

In view of the above amendments, Applicant believes the pending application is in condition for allowance.

If additional fees are due, please charge our Deposit Account No. 23/2825 under Docket No. H0498.70219US02 from which the undersigned is authorized to draw.

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Respectfully submitted,

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**APPENDIX A****Apl. No. 10/587,156; H0498.70219US02  
Claim amendments for discussion purposes only**

## 1. A method comprising:

providing a first and a second fluid maintained separately from each other by a third fluid in a common, sealed vessel, wherein the third fluid is adjacent to and substantially immiscible with the first and second fluids, and wherein the first, second and third fluids are stored within the common, sealed vessel for at least one day;

unsealing the vessel;

transferring the first, third, and second fluids in series from the vessel to a reaction site;

allowing the first, third, and second fluids to contact a surface of the reaction site;

to-carrying out a predetermined chemical or biochemical reaction at the surface of the reaction site; and

avoiding substantial contact between the first and second fluids, at least until after the fluids have been applied to the reaction site.